

Remarks

Objection to the Specification

The Office Action requested a new abstract on a separate page. The abstract accompanies this amendment.

Rejections Under 35 U.S.C. § 112 ¶ 2

Claim 1 is rejected as indefinite because it lacks a correlating step to accomplish the preamble of the claim. Claim 1 is amended to add the correlating step, which is supported by the preamble.

Claim 5 is rejected because there is insufficient antecedent basis for the recitation “the cell” in line 1. Claim 5 is amended to depend from claim 4, which recites “a cell.”

The amendments do not add new matter. Please withdraw the rejections.

Rejection Under 35 U.S.C. § 102(b)

Claims 1 and 5-9 are rejected under 35 U.S.C. § 102(b) as anticipated by Yuasa.¹ Applicants respectfully traverse the rejection.

A reference cited under 35 U.S.C. § 102 must expressly or inherently describe each element set forth in the rejected claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 recites, *inter alia*, a step of “identifying the test compound as a candidate therapeutic agent useful in the treatment of a disease selected from the group consisting of disorders of the peripheral and central nervous system, cardiovascular diseases, cancer, liver disease, and genitourinary disease if the test

¹ Yuasa *et al.*, *J. Biol. Chem.* 275, 31469-79, 2000.

compound binds to said PDE11A polypeptide.” Yuasa does not disclose this step. In fact, Yuasa teaches that the physiological role for PDE11A is unknown. Page 31478, col. 2, last full ¶. Yuasa therefore does not anticipate claim 1 or dependent claims 5-9.

Please withdraw the rejection.

Rejection Under 35 U.S.C. § 103(a)

Claims 1 and 4-11 are rejected under 35 U.S.C. § 103(a) as obvious over Yuasa in view of Lanfear.² Applicants respectfully traverse the rejection.

The U.S. Patent and Trademark Office bears the initial burden of establishing a *prima facie* case of obviousness. The *prima facie* case requires three elements:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Manual of Patent Examining Procedure, 8th ed., § 2142. Yuasa does not teach or suggest the third step of claim 1. Lanfear also does not teach or suggest this step. Claims 1 and 4-11 are therefore not *prima facie* obvious over the cited combination.

Please withdraw the rejection.

Respectfully submitted,
BANNER & WITCOFF, LTD.

/Lisa M. Hemmendinger/

Date: January 1, 2007

By: _____

Customer Number: 22907

Lisa M. Hemmendinger
Registration No. 42,653

² Lanfear *et al.*, US 2002/0115176.